

Remarks

Claims 1-15 are currently pending in the present application. The claims have not been amended herein. A listing of the claims is nevertheless provided for the convenience of the examiner.

In the Official Action mailed March 18, 2004, the Examiner required restriction to one of the following inventions under 35 U.S.C. § 121:

- I. Claims 1-4, 6, and 7 drawn to an ortho ester surfactant, classified in class 568, subclass 595.
- II. Claim 5, drawn to a process for preparing an ortho ester surfactant, classified in class 568, subclass 595.
- III. Claims 8, 14 and 15 drawn to a cleaning and scouring composition and a method for cleaning a hard surface, classified in class 568, subclass 595.
- IV. Claims 9-11 drawn to a method for separating a hydrophobic component from an aqueous system, classified in class 568, subclass 913.
- V. Claim 12, drawn to a dying or deinking process, classified in class 8, subclass 404.
- VI. Claim 13, drawn to a pesticidal formulation, classified in class 514, subclass 723.

In response to the restriction requirement, applicant **provisionally elects**, with traverse, to prosecute the invention of Group I claims 1-4, 6, and 7 on the merits.

Applicant does, however, respectfully submit that the restriction requirement is improper and should be withdrawn.

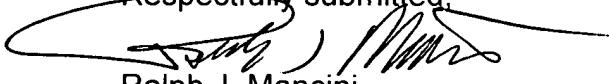
It is clear that the Examiner must satisfy two criteria in substantiating a proper restriction of the claims of an application. **First**, the Examiner must show that the application claims independent or distinct inventions, as required by both §121 and the PTO rules. **Second**, the Examiner must show that examining all claimed inventions in a single application would constitute a serious burden. M.P.E.P. §803. In the present situation, applicant respectfully submits that it **would not constitute a serious burden** to examine all of the claimed inventions in a single application. In this regard, the Examiner's attention is respectfully directed to the parent application for the present case, i.e., PST 6148, U.S. Serial No. 09/596,468.

The present Examiner was also the Examiner in the aforementioned **parent** application to the present case. In that **parent** application, **claims 1-4, 6 and 7** (comprising present **Group I** in the restriction), **claim 8** (part of **Group III** of the present restriction) and **claim 13** (comprises **Group VI** of the present restriction) were examined by the present Examiner and prosecuted all the way to Appeal. When the Appeal was unsuccessful, applicants filed the present case, along with additional comparative data. Accordingly, while applicant submits that it **would not** constitute a serious burden to examine **all of the claimed inventions** in a single application, at a minimum, it clearly should not be a serious burden to examine Groups I, III and VI comprising claims 1-4, 6, 7, 8, 13, 14, and 15 in a single application **as this was already done in the parent case.**

If the Examiner **refuses to withdraw** the restriction requirement in total, or at least as it relates to Groups I, III and VI, applicant respectfully requests a detailed explanation that supports such decision, especially in view of the record in parent application serial No. 09/596,468.

In view of the foregoing, applicant respectfully requests that the Examiner reconsider and withdraw the present restriction requirement, and issue an action on the merits with respect to all of the pending claims.

Respectfully submitted,



Ralph J. Mancini  
Attorney for Applicants  
Registration No.: 34,054

Akzo Nobel Inc.  
Intellectual Property Dept.  
7 Livingstone Avenue  
Dobbs Ferry, NY 10522-3408  
(914) 674-5465